



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,659	01/08/2002	L. David Waterbury	005699-512	5999

7590

07/22/2003

William H. Benz
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

HUI, SAN MING R

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 07/22/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,659

Applicant(s)

WATERBURY ET AL.

Examiner

San-ming Hui

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 15-22 and 33-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 23-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Applicant's election with traverse of the invention of Group IV in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the different groups of inventions are related because that are operated through the same mechanism of action to relieve neuropathic pain. This is not found persuasive because the different groups of invention operate through employing patentably distinct chemical compounds. As discussed before, they are different compounds: they have different classifications, different chemistry. It is well recognized as different and separate status of art. In other words, the different inventions operate differently by employing different compounds in the herein claimed methods. Therefore, the fields of search are diverse. The search is not limit to patent file. Searching for all the invention encompassed by the claims would present an undue burden to the Office.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-35 are pending.

Claims 15-22 and 33-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Claims 1-14 and 23-32 have been examined herein to the extent they read on the elected invention.

Claim Objections

Art Unit: 1617

Claims 1-14 and 23-32 are objected to because of the following informalities:

"treating neuropathic pain is a patient". It is apparently the word "is" is intended as "in".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-14 and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waterbury et al. (US Patent 6,342,523) in view of Harrison (Harrison's Principles of Internal Medicine, 13th ed., 1993, page 2378) and Kontani et al. (New England Journal of Medicine, 2000; 343: 1514-1519).

Waterbury et al. teaches the herein claimed compounds as useful for treating inflammation related disorder such as neuro-inflammatory conditions (See col. 1, line 65

Art Unit: 1617

to col. 2, line 2; also col. 4, line 45 – col. 5, line 3; also col. 6, line 20-63; col. 15, line 37-48).

Waterbury et al. does not expressly teach the employment of the herein claimed compounds as useful for treating neuropathic pain.

Harrison teaches herpes zoster is an acute inflammation in one or more dorsal root ganglia which can cause a persistent neuropathic pain, known as postherpetic neuralgia (See page 2378, col. 1, last two paragraph).

Kohtani et al. teaches antiinflammatory agents are effective in reducing the duration of postherpetic neuralgia with the extent of the pain relief (See particularly the abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the herein claimed compounds to treat neuropathic pain.

One of ordinary skill in the art would have been motivated to employ the herein claimed compounds to treat neuropathic pain. The herein claimed compounds are known to treat neuro-inflammatory conditions. Postherpetic neuralgia, a known neuro-inflammatory condition associated with neuropathic pain, is known to be effectively treated with anti-inflammatory agent. Therefore, possessing the teachings of the cited prior art, one of ordinary skill in the art would have been reasonably expected to employ the herein claimed aryl nitron ether/aryl nitron thioether compounds to treat any neuro-inflammatory conditions, including postherpetic neuralgia.

Art Unit: 1617

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



San-ming Hui
Patent Examiner
Art Unit 1617
July 21, 2003